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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/682,851	10/24/2001	Christopher Antonello	109.0023	9830

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EXAMINER

VIG, NARESH

ART UNIT PAPER NUMBER

3629

DATE MAILED: 03/22/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

**Application No.**

09/682,851

**Applicant(s)**

ANTONELLO ET AL.

**Examiner**

Naresh Vig

**Art Unit**

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 24 October 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-20 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- ☒ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: \_\_\_\_\_

## DETAILED ACTION

### *Claim Rejections - 35 USC § 101*

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claim 14 is rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

The basis of this rejection is set forth in a two-prong test of:

- (1) whether the invention is within the technological arts; and
- (2) whether the invention produces a useful, concrete, and tangible result.

For a claimed invention to be statutory, the claimed invention must be within the technological arts. Mere ideas in the abstract (i.e., abstract idea, law of nature, natural phenomena) that do not apply, involve, use, or advance the technological arts fail to promote the "progress of science and the useful arts" (i.e., the physical sciences as opposed to social sciences, for example) and therefore are found to be non-statutory subject matter. For a process claim to pass muster, the recited process must somehow apply, involve, use, or advance the technological arts.

In the present case, claim 14 only recites an abstract idea. The recited steps of merely providing a consumer with an identifier, authenticating the identifier received from consumer, and allowing consumers to access selection of offers does not apply, involve, use, or advance the technological arts since all of the recited steps can be

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performed in the mind of the user or by use of a pencil and paper. These steps only constitute an idea of how to provide access to the information to registered users only.

Additionally, for a claimed invention to be statutory, the claimed invention must produce a useful, concrete, and tangible result. In the present case, the claimed invention authenticating a consumer (i.e., repeatable) used in allowing authenticated consumer access to a selection of offers (i.e., useful and tangible). Although the recited process produces a useful, concrete, and tangible result, since the claimed invention, as a whole, is not within the technological arts as explained above, claim 1 is deemed to be directed to non-statutory subject matter.

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1 – 7 and 14 – 17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Price Watch Corporation hereinafter known as PriceWatch in view of HomeGain.com, Inc. hereinafter known as HomeGain.

Regarding claim 1, PriceWatch teaches method and system for an offer presentation system for identifying consumers as belonging to a designated category [page 19] and allowing access to offers by consumers who are members of the designated category [page 19 – 26]. PriceWatch teaches:

a database of offers accessible through connection by consumer operated computers upon authentication of consumer registration [page 26];

an offer presentation module for managing access to the database of offers [page 19 – 26];

registration of a consumer for access to the offer presentation module, the consumer registration module allowing registration of a consumer upon submission of identifying information provided to the consumer [page 26].

PriceWatch does not teach a consumer registration module allowing registration of a consumer for access to the offer presentation module, the consumer registration module allowing registration of a consumer upon submission of identifying information provided to the consumer by a party who has verified the consumer's membership in the designated category and used to identify the consumer as belonging to the designated category [page 26]. However, HomeGain teaches a consumer registration module allowing registration of a consumer for access to the offer presentation module, the consumer registration module allowing registration of a consumer upon submission of identifying information provided to the consumer by a party who has verified the consumer's membership in the designated category and used to identify the consumer

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as belonging to the designated category (licensed agent who are affiliated with a broker) [HomeGain page 52].

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify PriceWatch as taught by HomeGain to be able to limit the access to of the system and method to registered vendors only.

Regarding claim 2, PriceWatch in view of HomeGain teaches consumer registration module allows the consumer to select a unique consumer username and a password after providing the identifying information.

Regarding claim 3, PriceWatch in view of HomeGain teaches consumer registration module solicits personal information from the consumer during registration, associates the personal information with the consumer username and stores the personal information in association with the consumer username during registration [HomeGain page 52].

Regarding claim 4, PriceWatch in view of HomeGain teaches consumer registration module associates the consumer username with the identifying information and stores the identifying information in association with the consumer username during registration [HomeGain page 52].

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Regarding claim 5, PriceWatch in view of HomeGain teaches consumer registration module is hosted on a server connected to the Internet (both PriceWatch and HomeGain are accessed over the internet) and wherein the consumer gains access to the consumer registration module by activating a hypertext link to navigate to a web page serving as a portal to the consumer registration module (agents can review customer requirements and make proposal to clients, customers can review price of products offered by vendors etc.).

Regarding claim 6, PriceWatch in view of HomeGain teaches database of offers includes a hypertext link for each offer and wherein the consumer can activate the hypertext link for an offer in order to access the offer (link to dealer website) [PriceWatch page 23].

Regarding claim 7, PriceWatch in view of HomeGain teaches one or more offers is accessible only if predetermined conditions have been met (customers looking fans for hard-drives processors) [PriceWatch page 23].

Regarding claim 14, PriceWatch teaches system and method for presenting offers to consumers who are members of a designated category. PriceWatch teaches:

- allowing the consumer access to a selection of offers.
- allowing the consumer to register his identity.

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allowing the consumer access to a selection of offers.

PriceWatch does not teach providing a consumer with an identifier upon verification of the consumer's membership in the designated category by a party providing the identifier. However, HomeGain teaches providing a consumer with an identifier upon verification of the consumer's membership in the designated category by a party providing the identifier (licensed agent who are affiliated with a broker) [HomeGain page 52].

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify PriceWatch as taught by HomeGain to be able to limit the access to of the system and method to registered vendors only;

PriceWatch in view of HomeGain teaches:

receiving the identifier when presented by the consumer (HomeGain teaches SSL e.g. VeriSign) [HomeGain page 35];

authenticating the identifier (obvious to check that the identifier is not a duplicate identifier, e.g. SSL);

upon authentication of the identifier, allowing the consumer to register his identity (HomeGain teaches allowing customers to log in to the HomeGain system); and

upon completion of registration, allowing the consumer access to a selection of offers (after authenticating the customer, HomeGain allows customers to access the information designated for them).



Regarding claim 15, PriceWatch in view of HomeGain teaches receiving the identifier includes establishing a connection to a consumer computer upon a request by the consumer, presenting an initial login form for display on the consumer computer, the form including one or more fields for input of the identifier by the consumer, and receiving submission of the identifying information (logging into your account) [HomeGain page 38].

Regarding claim 16, PriceWatch in view of HomeGain teaches allowing the consumer to register his or her identity includes presenting a registration form for display on the consumer computer, the form including one or more fields for entry by the consumer of registration information including a consumer username and password selected by the consumer as well as for consumer personal information, receiving submission of the consumer username, password and consumer personal information and storing the consumer username, password and personal information in association with the identifier [HomeGain page 36, 51].

Regarding claim 17, PriceWatch in view of HomeGain teaches connection to the consumer computer is established over the Internet (both PriceWatch and HomeGain provide access to customers over the internet).

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Claims 8 – 13 and 18 – 20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Price Watch Corporation hereinafter known as PriceWatch in view of HomeGain.com, Inc. hereinafter known as HomeGain and Grandcolas et al. European Patent EP 1,089,516 hereinafter known as Grandcolas.

Regarding claim 8, PriceWatch in view of HomeGain does not teach activating a hypertext link for an offer causes the transmission of the identifying information, the consumer username and the consumer personal information to a server hosting the offer. However, Grandcolas teaches methods and systems for single sign-on user access to multiple web servers.

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify PriceWatch in view of HomeGain as taught by Grandcolas to implement a single sign-on user access to multiple servers.

Regarding claim 9, PriceWatch in view of HomeGain and Grandcolas teaches consumer username and personal information is examined to determine if the consumer meets any predetermined conditions established for access to the offer (HomeGain teaches to authenticate the users).

Regarding claim 10, PriceWatch in view of HomeGain and Grandcolas teaches server hosting the offer is able to retain the consumer personal information for use in future marketing efforts.

Regarding claim 11, PriceWatch in view of HomeGain and Grandcolas teaches server determines which offers are available to the consumer depending on the identifying information associated with the consumer username (HomeGain teaches customers can examine the proposals from agents designated for them).

Regarding claim 12, PriceWatch in view of HomeGain and Grandcolas teaches capability for party identifying the consumer as belonging to the designated category is a lender (business choice) and wherein the identifying information is provided to the consumer when the consumer has applied for home financing with the lender (field of use).

Regarding claim 13, PriceWatch in view of HomeGain and Grandcolas teaches party identifying the consumer as belonging to the designated category is a lender (business choice) and wherein the identifying information is provided to the consumer when the lender has judged that the consumer is a serious prospect to apply for home financing with the lender (business choice to elect when to cater the customer's request).

Regarding claim 18, PriceWatch in view of HomeGain does not teach initial login form is a web page including a hypertext link for submission of the identifying information and the registration form is a web pages including a hypertext link for

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submission of the registration information. However, Grandcolas teaches methods and systems for single sign-on user access to multiple web servers.

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify PriceWatch in view of HomeGain as taught by Grandcolas to implement a single sign-on user access to multiple servers.

Regarding claim 19, PriceWatch in view of HomeGain and Grandcolas teaches registering the identity of the consumer is followed by the step of presenting a login form to the consumer (design choice to login user right after successful registration, e.g. [www.hotmail.com](http://www.hotmail.com), mail.yahoo.com, or, after successful registration, present a login screen for the customer to log into the system, e.g. [www.nasafcu.com](http://www.nasafcu.com)), the login form including one or more hyperlinks which can be activated by the consumer in order to gain access to offers. (HomeGain teaches to authenticate the users).

Regarding claim 20, PriceWatch in view of HomeGain and Grandcolas teaches allowing the consumer access to the selection of offers includes presenting a selection of offer descriptions to the consumer, each offer description being accompanied by a hyperlink which can be activated by the consumer in order to retrieve additional information and offer materials (link to dealer website) [PriceWatch page 23].

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**Conclusion**

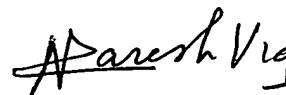
The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Applicant is required under 37 CFR '1.111 (c) to consider the references fully when responding to this office action.

1. Information on E-Loan, Inc.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Naresh Vig whose telephone number is 703.305.3372. The examiner can normally be reached on M-F 7:30 - 5:00 (Alt Friday off).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Weiss can be reached on 703.308.2702. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Naresh Vig  
Patent Examiner  
March 16, 2005